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SEP 19 2007

Applicant: Froggatt et al.

Appl. No.: 10/520,819

International Filing Date: July 8, 2003

Title: POLARIZATION DIVERSITY DETECTION WITHOUT A POLARIZING BEAM
SPLITTER

Attorney Docket No.: 3926-20

Pub. No.: US 2006/0164627 A1

Pub. Date: July 27, 2006

OFFICE OF PETITIONS

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on July 28, 2006, for the above-identified application

The request is granted-in-part.

Applicant requests that the application be republished because the patent application publication contains material errors, wherein the preliminary amendment to the specification was not included in the publication, letters which were italicized in the specification were not italicized in paragraphs [0009], [0010], [0038] and [0040], paragraph [0034] includes the letters "pr" before the word "processed", and there are errors in the formulas in paragraphs [0040] and [0042].

37 CFR 1.221 (b) is applicable "only when the Office makes a **material mistake** which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹

The request for republication of the application with respect to the errors labeled 6, 9 and 10 is GRANTED. The corrected patent application publication will be published in due course, unless the patent issues before the application is republished.

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

The errors wherein certain letters in paragraphs [0002], [0010]], [0038] and [0040] were not italicized as presented in the application as filed may be Office errors, but pre-grant publications do not include italicization in the letters within paragraphs.

The error noted by requestor with respect to the preliminary amendment is not an Office error. The patent application publication does not include a mistake regarding the failure to include the preliminary amendment to the specification in the publication by the Office because patent application publications are not required to include preliminary amendments, according to 37 CFR 1.215(a),² which says the following, in part:

(a) ... The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. **The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under Sec. 1.125(b),** amendments to the abstract under Sec. 1.121(b), amendments to the claims that are reflected in a complete claim listing under Sec. 1.121(c), and amendments to the drawings under Sec. 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. (emphasis added)

§ 1.215(c) says the following:

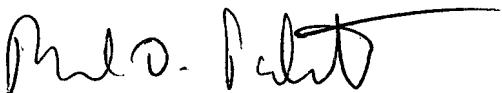
(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

While the patent application publication may now include a preliminary amendment, the Office is not required to use the preliminary amendment. The Office changed the procedures for publication of patent applications so as to publish applications as amended, when possible. Until 2004, patent application publications were published as originally filed. See Patent Application Publications May Now Include Amendments, 1281 Off. Gaz. Pat. Office Notices 53 (April 13, 2004) and MPEP 1121. Applicant did not file a substitute specification, which incorporated the preliminary amendment. See Pre-Grant Publication Helpful Hint: File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application, 1251 Off. Gaz. Pat. Office Notices 54 (Oct. 9, 2001). The Office correctly published the application in accordance with 37 CFR 1.215(a).

²Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan; Final Rule, 69 FR 56482 (Sept. 21, 2004).

Applicant is advised that he may want to file application papers that are clearer, as some of the error may be due to the quality of the text. The text in the application in some of the formulas is small and not clear, which makes it difficult to read and to electronically reproduce by digital imaging and optical character recognition. Applicants have been advised to file applications having cleaner and larger text with sufficient clarity and contrast to permit reproduction, such as electronic reproduction by digital imaging and optical character recognition, which will avoid errors in the patent application publication process. See 37 CFR 1.52.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.



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